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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/580,493	12/29/95	BERNA	P

QM21/0521

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EXAMINER

HUGHES, S

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 05/21/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 4/8/98
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-7, 11-16 is/are rejected.
- ☒ Claim(s) 8, 9, 10, 17, 18 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 3206

Drawings

1
2 1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show
3 every feature of the invention specified in the claims. Therefore, the subject matter of
4 claims 12-15 must be shown or the feature(s) canceled from the claim(s). No new
5 matter should be entered.
6

Specification

7
8 2. The substitute specification filed September 5, 1995 is objected to because
9 many phrases are not in proper idiomatic English. For instance, the sentence bridging
10 lines 31 and 32 of page 2 the specification ("Therefore, the new clamp...what cannot do
11 prior art clamps...") reads awkwardly and is not written in proper idiomatic English.
12 Also, at page 2, the sentence bridging lines 42 and 43, "One at least of said two
13 arms..." is awkward, confusing and not written in proper idiomatic English. Correction
14 of all such instances of improper use of the English language in the specification, the
15 number of which is too great to list individually, is required.

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Claim Rejections - 35 USC § 112

3. Claims 4, 5, 7 and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, the language "so that they could overlap" is vague and indefinite. In general, the wording in this claim is vague, indefinite and confusing (e.g. "every of said movable arms"; "said four ones"; "could have their contact faces...").

In claim 7, the language "so as to turn of said two arms those which are..." is vague, indefinite and confusing.

In claim 15, it is not clear what a loop-shaped gland is.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, there is no support for a "loop-shaped" gland.

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Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3 and 11-16 are rejected under 35 U.S.C. § 103 as being unpatentable over Neff in view of Thornton.

Neff teaches a device for clamping objects comprising a cylindrical support 10 on which is mounted a first arm 12 and a second arm 14,16. The arms can slide along the support and are able to rotate thereabout. Neff, however, does not teach fitting the arms with elastic buffers at their ends.

Thornton teaches fitting the arms of a clamp structure with rubber clamping pads at their ends.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to provide the clamping arms of Neff with elastic pads, in light of the teachings of Thornton, in order to protect the object being clamped. Note that the contact faces of Neff are at right angles to the support part and that the pads taught by Thornton can be considered rings which cover the end of each arm.

The arms of Neff are manually moved into contact with the object being held and are then released so as to lock each of the arms by tilting them against the support part. Note that the support part of Neff can be considered to be made of several beams

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1 connected together by couplers as claimed in claim 11 and that the elastic buffer can
2 be considered to be split up into pieces.

3 8. Claims 4-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Neff
4 in view of Thornton as applied to claims 1-3 and 11-16 above, and further in view of the
5 EPO 0080960 patent to Berna.

6 Neff in view of Thornton teach the invention except for additional sets of
7 movable arms placed on the support part.

8 Berna, in figure 3 of the EPO patent, teaches providing a support part of a
9 clamping device with multiple sets of movable arms.

10 It would have been obvious to one of ordinary skill in the art, at the time of
11 invention, to provide the support part of Neff/Thornton with additional movable arms, in
12 light of the teachings of Berna, in order to be able to hold more than one object at a
13 time. Note that one of ordinary skill would be fully capable of adding additional sets
14 (more than two) of movable arms to the support part, depending on the number of
15 objects being held.

16 9. Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Neff in
17 view of Thornton as applied to claims 1-3 and 11-16 above, and further in view of Ditto.

18 Neff in view of Thornton teach the invention except for an end of the support part
19 being fitted with a removable stop.

20 Ditto teaches providing a support part in a clamp with an end cap 32.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to provide the support part of Neff/Thornton with an end cap, in light of the teachings of Ditto, in order to protect the users hand. Note that the end cap of Ditto can function as a stop and is removable from the support part.

Allowable Subject Matter

10. Claims 8, 9, 10, 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed April 8, 1998 have been fully considered but they are not persuasive.

Regarding applicant's arguments pertaining to the Neff and Thornton combination, the examiner maintains that the motivation to combine the references is found in that clamping pads are usually provided to protect the workpiece and to provide a better grip on the workpiece. Although Thornton does not expressly state this motivation, a conclusion of obviousness may be made from "common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference". *In re Bozek*, 416 F.2d 1385, 163 USPQ 545, 549

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1 (CCPA 1969). Severe modification would not be necessary, only the inclusion of pads
2 on the ends of the arms of Neff. The rubber pads disclosed by Thornton do behave like
3 compression springs as argued by applicant.

4 Regarding applicant's arguments directed towards the Neff/Thornton/Berna
5 combination, the examiner maintains that the motivation to combine Berna with Neff
6 and Thornton is that Berna clearly teaches that there is an advantage to using more
7 than one set of clamping arms. This motivation is found directly in the Berna reference.
8 Again, common sense would dictate that if an advantage is found in using more than
9 one set of clamping arms, then 3 sets would be an advantage over 2 sets, and 4 sets
10 would be an advantage over 3 sets, and so on and so on.

11 Regarding the combination of Neff/Thornton/Ditto, the stops of Ditto are able to
12 be removed. Again, the combination is found directly in the patent to Ditto, in order to
13 protect the user's hands.

14 12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
15 policy as set forth in 37 CFR 1.136(a).

16 A shortened statutory period for reply to this final action is set to expire THREE
17 MONTHS from the mailing date of this action. In the event a first reply is filed within
18 TWO MONTHS of the mailing date of this final action and the advisory action is not
19 mailed until after the end of the THREE-MONTH shortened statutory period, then the
20 shortened statutory period will expire on the date the advisory action is mailed, and any
21 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
22 the advisory action. In no event, however, will the statutory period for reply expire later
23 than SIX MONTHS from the mailing date of this final action.
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